

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | |
|----------------------------|--|
| Appellants | Gary S. Foster, <i>et al.</i> |
| Application No. 09/930,920 | Filing Date: August 16, 2001 |
| Title of Application: | Prorating Of Contract Notes In System For Facilitating Trade Processing And Trade Management |
| Confirmation No. 2564 | Art Unit: 3693 |
| Examiner | Dass, Harish T |

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Reply Brief Under 37 CFR §41.41

Dear Sir:

Having received the Examiner's Answer, Appellant submits this Reply Brief for the above-captioned application pursuant to 37 C.F.R. §41.41 as follows.

Reply to Examiner's Responses

Appellant has fully set forth its arguments for patentability in its previously filed Appeal Brief. Herein, Appellant briefly addresses the Examiner's Responses to Appellant's arguments, as set forth in the Examiner's Answer.

In his Examiner's Answer, Section 10, Page 7, the Examiner asserts that "the features upon which applicant relies (i.e., a system for facilitating the processing and settlement of an already executed securities trade) are not recited in the rejected claim(s). Appellant completely disagrees with this assertion.

Although Appellant recognizes that the rejected claims do not specifically use the exact term "an already executed securities trade", Appellant respectfully submits that the requirements that are recited in all of the rejected claims do limit the claims to an already executed securities trade. For example, as clearly set forth in the Appeal Brief in the very sentence following the one containing the term "an already executed securities trade", Appellant points to claim recitations of "trade execution information indicative of an executed securities trade by a first trading party" and "trade allocation information indicative of an ordered securities trade by a second trading party". These recitations clearly require that the claimed system be one for facilitating the processing

and settlement of an already executed securities trade, and Appellant believes that the Examiner's attempts to deny such are disingenuous.

The Examiner further states that "With broadest reasonable interpretation of the claimed limitation Kawashima et al. is in the same field of invention of financial clearing and settlement..." and that "Applicant admits (page 11 of AB) that Kawashima et al. relates to monetary securities (an analogous art), also see *In re Oetiker*", and then goes on to apparently equate various limitations of the claims with various elements of Kawashima et al. simply because the Kawashima et al. is analogous art. Appellant respectfully submits that this analysis is erroneous.

Appellant respectfully submits that the question as to whether a prior art reference is in the same field of invention as the claimed invention, and the related question of whether or not a prior art reference is analogous art, is pertinent to the analysis of whether the reference is properly cited at all as part of a rejection under 35 U.S.C. 103(a). However, even if a reference is analogous art, and is therefore properly cited, the Examiner must still show why each and every claim limitation is anticipated, or obvious in view of, the cited prior art.

Here, Appellant has never attempted to disqualify any of the cited prior art as being nonanalogous. Rather, Appellant pointed out in its Appeal Brief how the Examiner has failed to show that one skilled in the art would reasonably interpret various elements of the cited prior art as satisfying various claim limitations. The Examiner has, in the Examiner's Answer, again failed to provide any support whatsoever for his conclusion that these elements are satisfied. Rather than attempting to ascertain the level of ordinary skill in the art, and then explaining why one possessing that level of ordinary skill in that art would, for example, understand the sums payable information disclosed by Kawashima et al. as satisfying the limitation of all claims requiring "trade execution information indicative of an executed securities trade by a first trading party", the Examiner apparently assumes such to be so simply because Kawashima et al. relates to the "same field of invention" and is "analogous art". This is not the proper test for establishing a prima facie case of obviousness.

Moreover, in the Examiner's Answer, the Examiner, in the paragraph beginning on the bottom of page 8, further clarifies that Hitachi and Wilton et al. are merely secondary references cited for very limited teachings. This highlights the fact that the Examiner is relying solely upon Kawashima et al. as disclosing almost all of the limitations required by the independent claims, which limitations Appellant respectfully

believes are completely missing therefrom for the reasons discussed above and in its Appeal Brief.

Finally, the Examiner has made an observation that “Applicant’s limitation uses ‘if’ statement, which implies if the ‘if’ statement is not satisfies, the process exits without any further processing, which means the process stops and there if no reason for examination of the limitations following ‘if.’” While Appellant does not fully understand this statement, it appears that the Examiner is saying that because the “if” statement may not always be satisfied, that there is no need to examine the limitations following the “if” statement. If this is the case, Appellant can find no support for this proposition in either the MPEP or case law. Moreover, Appellant respectfully submits that the “if” statements contained in the claims are clear and easily understood by those having ordinary skill in the art, and that these statements do not render the claims indefinite in any way. As such, Appellant can not conceive of why the Examiner would apparently believe that the axiom of patent law requiring that each and every claim limitation be considered would not apply.

For the foregoing reasons, as well as those set forth in Appellant’s previously filed Appeal Brief, Appellant respectfully submits that the claimed invention embodied in

Reply Brief Under 37 C.F.R. §41.41
Serial No. 09/930,920
Page 6

each of Claims 1-26 is patentable over the cited prior art. As such, Appellant respectfully requests that the rejections of each of Claims 1-26 be reversed.

Respectfully submitted,

March 28, 2008

/Wesley W. Whitmyer, Jr./
Wesley W. Whitmyer, Jr., Registration No. 33,558
Todd M. Oberdick, Registration No. 44,268
Attorneys for Appellant
ST.ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
203 324-6155